REMARKS

In the Office Action mailed March 5, 2007, the Examiner objected to claim 9; rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over *Tagawa et al.* (U.S. Patent No. 6,834,348) in view of Examiner's Official Notice; and rejected claim 25 under 35 U.S.C. § 102(e) as being anticipated by *Tagawa et al.*

By this amendment, Applicants amend claims 9 and 24. Claims 1-24 are pending in this application.

Regarding the objection of claim 9 for minor informalities, Applicants herein amend claims 9 and 24 to replace the term "description" with "decryption." Accordingly, Applicants respectfully request that the objection to claim 9 be withdrawn.

Applicants respectfully traverse the rejection of claim 25 under 35 U.S.C. § 102(e) as being anticipated by *Tagawa et al., because Tagawa et al.* fails to disclose each and every element of claim 25.

Independent claim 25 recites a recording medium storing a computer-readable program for transferring encrypted content data, the program comprising:

> discriminating between said first external apparatus which can record only encrypted content data to said second memory and said second external apparatus which can record only decrypted content data to said third memory;
>
> . . .
>
> if said second external apparatus is discriminated, disabling the return of the encrypted content data from said second external apparatus.

Tagawa et al. fails to disclose at least the above claim recitations. *Tagawa et al.* discloses managing, through a "Usage Rule," the recording of copyrighted material on a portable recording medium using a "check-out" and "check-in" process. (*Tagawa et al.*, 2:3-7 and 11:4-8.) *Tagawa et al.* also discloses that the "Usage Rule" protects against

recording of the copyrighted material regardless of whether the device connected to the portable recording medium is a compatible device or an incompatible device. (*Id.* at 9:5-25 and 11:26-41.) [D]evices compliant with the SDMI, the SD-Audio Ver1.0 standard, and the SD-Audio Ver1.1 standard are know as compatible devices, and devices not compliant with any of these standards are incompatible devices." (*Id.* at 6:34-37.) Accordingly, the restriction of the recording of the copyrighted material on the portable recording medium is determined by the "Usage Rule." Therefore, *Tagawa et al.* does not disclose "discriminating between said first external apparatus which can record only encrypted content data to said second memory and said second external apparatus which can record only decrypted content data to said third memory," as recited in claim 25.

Furthermore, *Tagawa et al.* discloses, "the copyrighted material recorded on the SD memory card 100 cannot be recorded onto another recording medium without the Usage Rule." (*Id.* at 11:39-41.) Therefore, *Tagawa et al.* cannot disclose "if said second external apparatus is discriminated, **disabling the return** of the encrypted content data from said second external apparatus," as recited in claim 25.

Tagawa et al. therefore does not disclose each and every element of independent claim 25. Accordingly, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 102(e) and the timely allowance of claim 25.

Applicants respectfully traverse the rejection of claims 1-24 under 35 U.S.C. § 103(a). *Tagawa et al.* in view of the Examiner's Official Notice fails to establish a *prima facie* case of obviousness.

Regarding claims 1, 9, and 17, as discussed above, *Tagawa et al.* does not disclose "discriminating between said first external apparatus which can record only encrypted content data to said second memory and said second external apparatus which can record only decrypted content data to said third memory," as recited in claim 17, and similarly recited in claims 1 and 9. The Examiner's assertion of Official Notice does not cure the deficiency of *Tagawa et al.* Indeed, the Examiner has only asserted Official Notice for the alleged disclosure of a "decryption means for decrypting said content data encrypted in a predetermined manner received by said receiving means." (*Office Action*, p. 6.) Applicants also do not acquiesce in the Examiner's Official Notice. Moreover, the recitation of a "decryption means" is not present in claims 1 and 17 as alleged by the Examiner.

Applicants thus respectfully request the withdrawal of this rejection and the timely allowance of claims 1, 9, and 17.

Dependent claims 2-8, 10-16, and 18-23 are also allowable at least for the reasons set forth above in connection with independent claims 1, 9, and 17. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2-8, 10-16, and 18-23 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Independent claim 24 recites a data recording apparatus comprising, among other things:

> control means for disabling the return of said content data from said second recording medium to said data transfer apparatus through said communication means.

Tagawa et al. fails to disclose at least the claimed control means. Instead, *Tagawa et al.* discloses a "check-in" process wherein a "process of returning copyrighted material recorded on a portable recording medium to the personal computer" is performed. (*Tagawa et al.* 1:45-47 and 11:3-7.) *Tagawa et al.* discloses a limitation on the copying of the copyrighted material and not a limitation on the return of the copyrighted information. (*Id.* at 11:41-45.) As a result, *Tagawa et al.* fails to disclose a "control means for disabling the return of said content data from said second recording medium to said data transfer apparatus through said communication means," as recited in claim 24. The Examiner's assertion of Official Notice does not cure the deficiency of *Tagawa et al.* as discussed above. Again, the Examiner has only asserted Official Notice for the alleged disclosure of a "decryption means for decrypting said encrypted content data supplied from said data transfer apparatus through said communication means." (*Office Action*, p. 11.) Applicants also do not acquiesce in the Examiner's Official Notice.

An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). Applicants submit that the "decryption means" recited in claims 9 and 24 is not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Accordingly, Applicants traverse the Official

Notice and request that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or else withdraw the rejection.

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. The preceding arguments are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 4, 2007

By: 

Arthur A. Smith
Reg. No. 56,877
/direct telephone: (202) 408-4049/